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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,705	10/12/2005	Janne Parantainen	915-001.053	2037
4955 7590 09/10/2008 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468				
EXAMINER STEPHEN, EMEM O				
ART UNIT 2617		PAPER NUMBER		
MAIL DATE 09/10/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/529,705

**Applicant(s)**

PARANTAINEN, JANNE

**Examiner**

EMEM STEPHEN

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-58 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9, 11-58 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 05/15/2008 have been fully considered but they are not persuasive.

The Applicant's argument with respect to claim 15 is not persuasive for the reason that the applicant's claim states "method comprising ....." "The transition term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (MPEP 2111.03). The Applicant's claim language is inclusive of other unrecited elements and method steps, therefore, the rejections are maintained and repeated below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9, 11-14, 23-29, 33-46, 51-55, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,600,917 B1 to Maupin.

Regarding claims 1, 23, 33, and 51, Maupin discloses a terminal, a network element, a system and a method comprising: transmitting, by a network element in a wireless communication system (see figs. 1, and 6), a broadcast or multicast message

indicating terminal capability requirements for point-to-multipoint MBMS service reception in a wireless system over an air interface to at least one terminal within the service range in order to allow the terminal to determine whether it is capable of receiving the service or not (see fig 6 steps 1-4, col. 2 line 64-col. 3 line 20, col. 6 lines 12-19, col. 8 line 36-col. 9 line 8), said requirements being indicated in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (col. 1lines 34-55, col. 2 lines 57-61, radio access technology type and generation and bits).

Regarding claims 55 and 58, Maupin discloses a computer readable medium stored with machine-readable instructions that upon execution by a programmable apparatus (see fig. 2, and col. 5 lines 26-35) make the apparatus receive a message indicating requirements for point-to-multipoint Multimedia Broadcast/Multicast Service service reception (see fig. 6 step 2) and further to determine on the basis of said requirements whether it is capable of receiving the service or not (fig. 6 step 4), said requirements indicated in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (col. 6 lines 51-55).

Regarding claim 2, Maupin discloses the method of claim 1, wherein a decision of whether to receive the service or not is made in the terminal on the basis of said indication (col. 8 line 47-col. 9 line 8).

Regarding claim 3, Maupin discloses the method of claim 1, wherein it further comprises a step wherein said requirements for receiving the service are defined (col. 8 line 60-col. 9 line 3).

Regarding claim 4, Maupin discloses the method of claim 1, wherein further comprises a step wherein the service-related data is transmitted in conformity with indicated requirements (col.9 lines 8-55).

Regarding claims 5, and 24, Maupin discloses the method of claim 1, wherein said requirements are indicated in said message implicitly with an identifier associated to a certain set of requirements (see fig. 5).

Regarding claims 6, 25, 37-38, and 53, Maupin discloses wherein said requirements are indicated in said message explicitly with parameters (see figs. 4-5).

Regarding claims 7-9, 27, 29, and 39-41, Maupin discloses wherein said system is substantially GSM /GPRS or UMTS system (see fig. 1, and par. 7 line 30).

Regarding claim 11, Maupin discloses the method of claim 1, wherein said message is sent by the Center cell broadcast centre or radio network controller/base station controller (col. 6 lines 12-18).

Regarding claims 12-14, 26, 28, 34, 42-46, and 52, Maupin discloses wherein said message is substantially a schedule message, characterized in that said schedule message is CBS service specific (col. 2 lines 64-67).

Regarding claims 36, and 54, Maupin discloses wherein said network element further comprises means for receiving said requirements for point-to-multipoint service reception prior to sending said message indicating said requirements (col. 4 lines 54-63, and col. 6 lines 17-19).

4. Claims 15-16, 19-20, 30, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6006091 to Lupien.

Regarding claims 15, 30, and 47, Lupien discloses a terminal, a network element, and a method comprising (see fig. 1, and col. 5 lines 30-42), informing a terminal's capabilities for point-to-multipoint Multimedia Broadcasting/Multicasting Service service reception in a wireless communication system (see fig. 1, and col. 5 lines 30-42) in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class, to said wireless communication system in order to enable the wireless communication system to deduce on the basis of the informed data whether the terminal is capable of receiving the service or not (see fig. 1 step 15-18, col. 1 lines 15-17, col. 5 lines 45-55, col. 6 line 30-col. 7 line 10, and col. 9 lines 1-15).

Regarding claims 16, and 48, Lupien discloses further comprising the wireless communication system either accepting or rejecting a join requested by the terminal based on said deduction (col. 5 lines 45-56, and col. 6 lines 1-3).

Regarding claims 19, Lupien discloses the method of claim 15, wherein said informed data indicates at least one of the following features supported by said terminal: time slot configuration, modulation type, bit rate, and capability class (see tables 1-2 and col. 5 lines 45-56).

Regarding claims 20, Lupien discloses the method of claim 15, further comprising transmitting the service-related in conformity with indicated requirements (see table 2-3, col. 7 lines 15-20, and col. 9 lines 1-5).

5. Claims 56-57 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pub No. 2006/0156370 A1 to Parantainen.

Regarding claim 56-57, Parantainen discloses a computer readable medium stored with machine-readable instructions that upon execution by a programmable apparatus (see fig. 9, and pars. 19-22, and 53-54) make the apparatus inform its capabilities in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (see fig 6), to a system for the examination of fulfillment of point-to-multipoint Multimedia Broadcast/Multicast Service service

reception requirements, and send a message indicating requirements in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (see figs. 6-7), for point-to-multipoint Multimedia Broadcast/Multicast Service service reception to be delivered to at least one wireless terminal within the service range in order to allow said wireless terminal to determine whether it is capable of receiving the service or not (fig. 8, pars. 17-18, 48, and 51).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 17-18, 21-22, 31-32, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of US Pub. 2002/0071480 A1 to Marjelund.

Regarding claims 17-18, 21-22, 31-32, and 49-50, Lupien discloses the method above, however, Lupien fails to specifically disclose wherein said wireless



communication system is substantially GSM/GPRS or UMTS system, wherein said informing is performed over a radio access network that is substantially GERAN or UTRAN, and wherein said point-to-multipoint service is substantially a multicast service, characterized in that the air interface in said system is substantially in accordance WLAN specifications. Marjelund disclose wherein said system is substantially GSM GPRS or UMTS system, wherein said informing is performed over a radio access network that is substantially GERAN or UTRAN, and wherein said point-to-multipoint service is substantially a multicast service, wherein the air interface in said system is substantially in accordance WLAN specifications (see fig. 1, the use multicast service and WLAN are well known in the art). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Lupien in the system of Marjelund for the purpose of meeting with the user's preference.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM STEPHEN whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571 272 7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ES  
09/03/2008

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Supervisory Patent Examiner, Art Unit 2617